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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,142	04/22/2004	Kaveh Towfighi	DT-6799	7829
30377	7590	04/30/2008	EXAMINER	
DAVID TOREN, ESQ. ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621			MCDONOUGH, JAMES E	
		ART UNIT	PAPER NUMBER	
		1793		
		MAIL DATE		DELIVERY MODE
		04/30/2008		PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/830,142	<b>Applicant(s)</b> TOWFIGHI, KAVEH
	<b>Examiner</b> JAMES E. McDONOUGH	<b>Art Unit</b> 1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 April 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2,8-11,13 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2,8-11, 13, and 18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-166/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

**Original Rejection**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 8-11, 13, and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rosenbaum (US 2002/0005010) as evidenced by <http://www.sea-doo.net/techarticles/oil/oil.htm>; Feb 02, 2003; Robert Verret.

Regarding claims 2 and 18

Rosenbaum teaches a propellant for internal combustion-operated tools, and teaches that they can contain lubricants based on a mineral oil or silicone oil, and references 2-stroke engine oil (para 0020), which, certainly include and read on all the variously claimed lubricants. See Article by Robert Verret included, for a discussion of 2-stroke engine oil composition of API groups III, IV, and V based on hydrocracked/hydrotreated petroleum based oils (a.k.a. this reads on isoparaffin based on poly-olefins), synthetic based oils, and ester synthetic based oils (under section **base oil types**) respectively.

With regard to the boiling point and number of carbons in the branched isomer, these are properties of the composition, and since properties are inseparable from the composition itself, the reference would inherently have these properties, absent any showing to the contrary. Furthermore, Motorcraft sells three grades of 2-stroke oil 5W-20, 5W-30, and 10W-30, which have respective boiling points of 185, 210, and 226 °C, and since it is well known that as the number of carbons increases the boiling point goes up, it would further appear that the oils disclosed by the reference do indeed read directly on those of the instant claims, and if for arguments sake it could be argued that the reference for some reason does not anticipate the claims than they would at least be *prima facie* obvious to someone of ordinary skill in the art at the time the invention was made to use these lubricants, absent any showing of unexpected results.

Regarding claim 8

Here applicants appear to be trying to define the lubricant based on inherent properties of that lubricant, applicants are reminded that in no way do inherent

properties add to the patentability of a compositional claim, furthermore, applicants have not disclosed or provided enablement on where or how this oil can be obtained, if it is argued that this oil is indeed novel over those disclosed by the reference because of some unexpected result.

Regarding claims 9 and 10

Although, Rosenbaum does not disclose how much lubricant should be used, Rosenbaum does disclose that a lubricant can be used, however, because it is only one variable and is considered result effective, because as the lubricant concentration increases the machine would be expected to operate more smoothly and efficiently with less wear and tear, but as the lubricant concentration exceeded a certain amount it would start interfere the combustion reaction while at the same time adding no increased lubricating function, therefore, one skilled in the art would be expected to be able to optimize this parameter without undue experimentation to arrive at the claimed amounts.

Regarding claims 11 and 13

Rosenbaum teaches these exact amounts of the same exact reagent list (paras 0005 and 0006), it appears that these claims are verbatim with the disclosure of Rosenbaum, therefore, they are anticipated by the reference. Furthermore, looking at the claim set of the reference it can clearly be seen that the elected species are also disclosed individually, preempting any argument against picking and choosing components from the reference.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not understood by the examiner how a carbonaceous fuel can burn without producing a residue, as it is well known that all carbonaceous materials when burned will produce a residue, even if it is only condensed water.

**Response to Arguments**

It is noted by the examiner that claim 1 was cancelled and not amended, and that the pending claims are 2, 8-11, 13, and 18, not claims 1, 2, 4-11, and 13 as alleged by applicants.

Applicants argue that claim 18 requires a mixture of no more than 50 % of C9-C12 branched alkanes and not less than 50 % branched C10-C14 alkanes. This is not persuasive as this claim limitation was addressed in the last rejection, and applicants have not argued why the lubricating agents of the reference do not read on this lubricant. Since it is known that oils/lubricants are often hydrocarbons/parrafins, and that as the molecular weight increase so to does the boiling point, and since many grades of

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oil/lubricants are sold depending on operating temperature, there would be expected to be a range of different number carbon chains, and the higher weight oils have higher carbon numbers in their structures. It is further noted by the examiner that the skilled artisan would be able to optimize the lubricating/combustion properties of the lubricant, absent any showing of criticality or unexpected results.

Applicants argue that the prior art lubricants will upon combustion leave residues, however, applicants have not shown that the lubricants of the reference will leave these residues where the claimed lubricant will not. It is also noted by the examiner that applicants had a range of lubricants, that applicants alleged will not produce any residue, but now applicants are stating that only the alkane mixture will not produce any residue, and applicants have failed to provide any evidence or reasoning that would lead one skilled in the art to believe that the lubricant of the invention will not produce any residue, while the lubricant of the reference will.

Applicants argue that the reference does not explicitly teach that their lubricants contain a mixture of not more than 50 % C9-C12 branched alkanes and not less than 50 % C10-C14 branched alkanes having a defined boiling point. This is not persuasive because the reference teaches lubricants reading on the claimed boiling points, and applicants have provided no reasoning that the skilled artisan would believe that the reference lubricants would not read on the instant invention.

Applicants argue that their lubricant does not leave behind any residues because of its high volatility, however, the examiner notes that the boiling points go up 250 C, and liquids with this high boiling point are typically not considered volatile.

Applicants argue that their lubricant and fuel burn completely, however, it is noted by the examiner that few if any combustion reactions ever burn completely.

### **Conclusion**

This is a continuation of applicant's earlier Application No. 10/830,142. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES E. MCDONOUGH whose telephone number is (571)272-6398. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571)272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry A Lorengo/  
Supervisory Patent Examiner, Art Unit 1793

JEM 4/24/2008

<b>Application Number</b> 	<b>Application/Control No.</b>	<b>Applicant(s)/Patent under Reexamination</b>
	10/830,142 <b>Examiner</b> JAMES E. McDONOUGH	TOWFIGHI, KAVEH <b>Art Unit</b> 1793